

(A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process.

M.P.E.P. §806.05(e) (emphasis added). Thus, to show that condition (B) is satisfied, the restriction must demonstrate that the claimed apparatus (i.e., Group I) can perform a process materially different from the process set out in the other restricted group (i.e., Group II)—“another materially different process.” In the instant example, the restriction simply asserts that the apparatus of Group I can practice the processes of claims 13 and 26. However, claims 13 and 26 are both restricted to Group II, and, regardless whether the processes of claims 13 and 26 are distinct from each other, the restriction fails to point to “another materially different process” other than that set out in Group II. Accordingly, the restriction does not proffer reasoning that, even if true, would satisfy condition (B).

The restriction does not assert that condition (A) is satisfied. Since neither condition (A) nor condition (B) is satisfied, the requirement is improper. Should the Examiner disagree with the argument above, the Examiner is respectfully requested to “provide reasonable examples” to buttress the restriction.

Second, the restriction has not established that there exists a serious burden on the Examiner, as required by M.P.E.P. §803(I) and 808.02. M.P.E.P. §808.02 states that a serious burden may be shown by demonstrating one of the following three conditions:

(A) Separate classification thereof: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), a different field of search is shown, even though the two are classified together. The indicated

different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. (Emphasis added)

Thus, all three conditions require that the restriction show a separate field of search for each of the groups. "Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s), a different field of search is shown." M.P.E.P. §808.02. In the present application, a search for Group II would result in finding art that is pertinent to Group I. Specifically, claims 1-11 of Group I include limitations that are the same as or similar to the limitations of some claims in Group II, such that the search for Group II would uncover art pertinent to all claims of Group I, with the possible exception of claim 12. For example, a search for claim 26 (Group II) would necessarily overlap with a search for claim 1 (Group I). The same can be shown for claims 13 and 2, claims 14 and 3, claims 15 and 4, claims 29 and 5, claims 31 and 6, claims 33 and 7, claims 51 and 8, claims 42 and 9, claims 24 and 10, and claims 25 and 11 (all of Groups II and I, respectively). Thus, it is believed that a serious burden would not exist for the Examiner to search both Groups. Therefore, the restriction is improper.

As shown above, the restriction has not demonstrated that Groups I and II are properly divided into a process and apparatus for its practice. It was further shown above that there would be no serious burden in searching both Groups. Accordingly, the restriction requirement is not proper. It is respectfully requested that the restriction requirement be withdrawn, and that each of claims 1-53 presently pending in this application be examined.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 50-1078, under Order No. 10021270-1 from which the undersigned is authorized to draw.



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Date of Deposit: November 8, 2006

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